In re Appln. of: Shulman et al.
Application No.: 09/970,409

automatically generating a passive assist window in response to a location of the positionable cursor, the passive assist window containing programming language statement information including at least one of selection menu information and information related to the programming language statement.

33. (New) The method of claim 32 wherein the passive assist window generates and disappears independent of user intervention.

34. (New) The method of claim 32 wherein the passive assist window permits a user typing the programming language statement to type through the programming language statement information, the passive assist window automatically altering the programming language statement information in response to the typing.

REMARKS

This paper is responsive to the Office Action dated March 29, 2002, and relates to the above-identified application with serial number 09/970,409, and filing date October 3, 2001. Claims 21-24 are pending in this application, stand rejected, and are at issue herein. Claims 25-35 have been added. Claims 22 and 24 stand rejected under the judicially-created doctrine of obviousness-type double patenting over Claims 1 and 29 of U.S. Patent No. 6,311,323. Claim 21 stands rejected under the judicially-created doctrine of the obviousness-type double patenting over Claim 6 of U.S. Patent No. 6,026,233. Terminal Disclaimers are filed herewith to address the rejections. Claims 21-24 further stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Smith*, U.S. Patent No. 5,485,618 (hereinafter "*Smith*").

The Applicant wishes to extend appreciation for the opportunity on May 15, 2002, to discuss the Office Action dated March 29, 2002, and to further discuss the rejections in the Office Action for clarification purposes on August 7, 2002. The Applicant would now like to address the concerns stated in the Office Action and respectfully requests reconsideration of the rejections based at least in part on the traversal provided below.

Rejection of Claims 21-24 - Smith

Applicant respectfully traverses the rejection over *Smith* and requests reconsideration of the rejection. To establish a prima facie case of obviousness, 35 U.S.C. § 103(a) requires that three criteria be met. There must be some suggestion or motivation to modify a reference or to combine reference teachings; there must be a reasonable expectation of success; and the prior art reference or references must teach or suggest all the claim limitations. *See* MPEP § 2142. As discussed below, *Smith* fails to provide a suggestion or motivation to modify itself, and fails to teach or suggest the claim limitations of Claims 21-24.

Claim 21 is directed to a computer-readable medium containing computer-executable instructions to perform a method including the element "automatically generating a passive assist window that contains said finite set of programming language statement information in a location proximate to said character position cursor that does not obstruct the current view of said programming language statement."

Unlike the automatic and passive system of Claim 21, *Smith* teaches an interactive development system with an "Expression Builder" for assisting a user with creating a programming expression. The Expression Builder dynamically adjusts an expression while a user is editing to maintain expression validity. *Smith,* Abstract. The Expression Builder further provides a user with the option to use a "Safety Net" which has an on and off mode. The Safety Net feature allows a user to complete valid expressions and warns of invalid expressions. Further, disabling the Safety Net is impossible "until a valid, complete expression has been formed." *Smith*, Col. 13, lines 60-61.

The Expression Builder further has a token mode, which includes "any electrical unit, placeholder, operator, function call, argument, reserved word or the like." *Smith*, Col. 17, line 6-11. The Expression Builder dynamically adjusts its display of tokens to reflect the current status of an expression. *Smith*, Col. 13, line 66 through Col. 14, line 2.

Referring now to the Office Action dated March 29, 2002, paragraph 5, *Smith* is cited as providing features for "invoking and/or displaying, pop-up/passive, edit box (window) by a 'click at or near' at such a cursor position, as needed." Citations from *Smith* include pop-up edit box/window in Fig. 3C, edit box 322, Fig. 4C, edit box 432 and Fig. 4E box 451, Col. 10, lines 45-54 and Col. 1, lines 32-55.

The Office Action further provides that one of ordinary skill in the art at the time of the invention would recognize "such known teachings in the windowing application art, pull-down menu, and/or pop-up box/window effect, and would include and/or modifying it (list boxes/windows 306, 307 and 308) into the *Smith '618* in such a location as claimed, as needed to get the same as such a passive, pull-down and/or pop-up, box/window effect." However, the cited references within *Smith* do not teach or suggest "automatically generating" or a "passive" assist window, as required by Claim 21. For example, Col. 11, lines 32-50, provides that Edit Box 432 appears when a user requests that Edit Box 432 appear. "The user may now click at or near the quotes and begin typing, whereupon the system displays an Edit Box 432 for receiving the user input. After the user has typed characters into the box, he or she presses Enter, whereupon the input is placed in the expression, as shown in Fig. 4D." Thus, *Smith* teaches an <u>interactive</u> system that is neither passive nor automatic. *Smith* continues in Col. 11 by providing that "the user may fill in the other parameters. For entering the second parameter for the function (i.e., the start value), the user clicks at or near the parameter, such as at position 441." *Smith*, Col. 11, lines 39-42. *Smith* continues by stating that:

> ...The user pastes the "zero" element 443 to the Expression Window. As shown by Fig. 4E, by right clicking next to the "zero" numeric placeholder, the user invokes a text box 451; keyboard entry while the caret is near the token will also invoke the text box. Here, the user can enter a numeric value and press Enter. The process is repeated for filling in a third parameter 452. The completed expression is evaluated and the result is displayed in window 453. When the user has finished the expression, he or she can click "Ok" to paste it into the window or dialog box from which the user started the Expression Builder." *Smith*, Col. 11, lines 44-54.

Importantly, the paragraph beginning in Col. 11, line 32 through the paragraph ending in Col. 11, line 54, provides six different user keystrokes for interacting with the Expression Builder. The keystrokes include clicking, pressing Enter, right clicking, clicking "Ok," and clicking at or near a parameter. Such required interactions with the Expression Builder do not teach or suggest "automatically generating a passive assist window," as required by Claim 21.

Further, the invoking of the text box 451, whether by clicking or otherwise, causes a text box to appear in interactive format. As shown in Figure 4E, once text box 451 is invoked, the cursor appears in the text box thereby requiring a user to type an entry in the text box. Such required interaction with the Expression Builder fails to teach or suggest a "passive" assist window as required by Claim 21. Accordingly, the *Smith* reference fails to provide some suggestion or motivation to modify itself to teach the elements of Claim 21 as required for a prima facie case of obviousness. See MPEP § 2143.01. Moreover, the *Smith* reference, as prior art, "teaches away" from the claimed invention because the reference teaches the benefits of requiring interaction between a user and the Expression Builder. For example, *Smith,* Col. 13, lines 60-65 describe the Result Window as requiring a valid, complete expression, forcing interaction by keeping the "Ok" button dimmed until a valid, complete expression is formed. Claims 22 through 24 depend from Claim 21 and are believed allowable with claim 21 for at least these reasons.

Regarding Claim 22, *Smith* fails to teach "automatically removing the passive assist window when the programming language statement has been amended" as required by Claim 22. More specifically, *Smith*, in Col. 11, as discussed above, teaches an interactive system requiring user input to accept changes. The "Edit box" discussed in Col. 11 of Smith is an edit box and not a "passive assist window" as required by Claim 22. The "Edit box" displays for "receiving the user input" and is not "passive" as required by both Claims 21 and 22. Furthermore, the "Edit box" is not "automatically" removed because the user must first press "Enter." Col. 11, line 37. Claim 22 requires "automatically removing . . . when the programming language statement has been amended" and not after pressing "Enter" as taught by *Smith*. Further, other boxes do not automatically disappear but require clicking "Ok" to paste entries in a text box into a dialog box before inputs are placed in an expression. Col. 11, lines 49, and 53; Fig. 4D, displays an "Ok" button at the bottom of the screen. Therefore, Smith fails to teach or suggest Claim 22, and a withdrawal of the rejection thereof is respectfully requested.

Applicant has added Claims 25-34. Support for Claims 25-34 is found in the Specification on Pages 6, 7, 14, 15 and 16, and in the originally-filed claims. They have been drafted in full consideration of the Examiner's comments in the Office Action dated March 29, 2002.

In re Appln. of: Shulman et al.
Application No.: 09/970,409

CONCLUSION:

The rejections of Claims 21, 22 and 24 under the judicially-created doctrine of obviousness-type double patenting have been addressed through Terminal Disclaimers. The rejection of Claims 21-24 under 35 U.S.C. 103(a) has been traversed, and new Claims 25-34 have been added. No new matter has been added thereby.

The Application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this Application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject Application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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8

In re Appln. of: Shulman et al.
Application No.: 09/970,409

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class mail in an envelope addressed to: Commissioner for Patents, BOX FEE AMENDMENT, Washington, D.C. 20231.

Date:_____August 27, 2002_____